

REMARKS

Claims 18-35 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over GB 2,324,381 issued to Allen ("ALLEN"). Claims 18-35 were rejected 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Denzinger *et al.* U.S. Patent No. 6,294,298 ("DENZINGER"). The applicants respectfully traverse these rejections.

The applicants' claimed invention is drawn to a recording material for the production of offset printing plates, which comprises a web- or plate-form support, a radiation-sensitive layer on the front of the support and a continuous, **pigment particle-free layer on the back**, and the **back layer consists essentially of an organic polymeric material having a glass transition temperature T_g of at least 45°C**, and said material has a surface and **said surface has a Bekk smoothness of from 5 to 800 s** (see claim 18). The back layer is pigment free, while the front layer can be pigment free or have pigments in it.

REJECTION OVER ALLEN AND DENZINGER

Claims 18-35 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over ALLEN. Claims 18-35 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being unpatentable over DENZINGER.

There is no teaching in ALLEN related to the T_g of the polymeric material included in the backing layer as is required by the applicants' claimed invention. Although the polymers listed on page 6, lines 1 to 5 can include, depending on the chemical structure and the polymerization degree, those with a T_g of 45⁰C or above as presently claimed. ALLEN fails to disclose such an election.

There is also no hint from ALLEN that the surface of the back layer should have a Bekk smoothness of from 5 to 800 s without the addition of pigment particles as presently claimed. Again the commonly known coating methods disclosed by ALLEN could have been adjusted to achieve such a Bekk smoothness, when knowing the present invention, but such an adjustment is not taught by ALLEN and was not known until the present invention was made.

As demonstrated in the present application with the application method R1 a typical roller application leads to a very smooth surface with a Bekk smoothness of 1700 s. See the table at page 23 of the specification.

Therefore the present invention is not inherently present in the materials disclosed by ALLEN and therefore new over ALLEN. As ALLEN gives no hint to use a back layer as presently claimed to achieve the advantages of the present invention, the present invention is also not rendered obvious over ALLEN.

The back coating of DENZINGER comprises polymeric material with a T_G as presently claimed (see col. 9, lines 20-23), but is silent with respect to a Bekk smoothness of 5 to 800 s achieved **without** the addition of pigment particles as presently claimed. It is acknowledged that DENZINGER refers to a Bekk smoothness of less than 1,000, preferably 20 to 250 seconds, but this is in reference to a pigmented material. See col. 3, lines 8-18 and 55-58. In particular DENZINGER discloses at col. 3, lines 8-18:

According to one aspect of the present invention, the pigmenting material is generally an inorganic material which is essentially insoluble in water. The mean particle size of the pigmenting particles is preferably from about 0.1 to about 20 μ , preferably from about 1 to about 15 μ , most preferably from about 3 to about 5 μ . The amount of the **pigmenting compositions is chosen such that the surface of the recording material has a Bekk smoothness which is preferably <1000 seconds, more preferably from about 20 to about 250 seconds**, as determined according to DIN 53 107, method A. (emphasis added)

According to DENZINGER, only the addition of pigments to a front side layer Leads to a good shelf life. There is no teaching in DENZINGER to provide the material with a back layer having a Bekk smoothness of 5 to 800 s. The doctor blade of column 10, line 64 is not said to be an imperfect method nor is it disclosed to use the doctor blade in an imperfect way to achieve a particular Bekk smoothness.

Examples 17 to 22 of DENZINGER, all having no pigment particles in the front layer(s), show an insufficient shelf life (see col. 12, lines 7-62, in particular D* and E* with no pigment in the layer and the results in the table at col. 15). The pigment used in the examples is silica gel filler. However, the plates of the present invention with the Fronts P1, P3, P4, N1 and N3 to E1, that lack a pigment as well, show a good shelf life (test 1) **when having a back layer with a Bekk smoothness of 5 to 800 s** (backs RS2 to RS10 (see the tables at pages 23 and 33 and 34 of the specification)) and an insufficient shelf life with the back RS1 (Bekk smoothness 1700 s (see the tables at pages 23 and 33 and 34 of the specification)).

Therefore, the Back coatings of DENZINGER had not a Bekk smoothness of 5 to 800 s and it is not suggested from DENZINGER to use such a back coating.

Therefore it is applicants' our opinion, that the present invention was neither known nor suggested at the time it was made and that the claims are patentable.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re

Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the reference in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction. For the above reasons, these rejections should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 07244-00120-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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